# UNITED STATES PATENT AND TRADEMARK OFFICE

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| 10/788,495 | 02/27/2004 | Frank F. Schmeyer | 35352.01.8001/3 | 7434 |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 10/788,495 | SCHMEYER ET AL. |
| | Examiner | Art Unit |
| | MURALI K. DEGA | 4176 |

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☐ Responsive to communication(s) filed on _____ .
2a)☐ This action is **FINAL**.        2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.
    4a) Of the above claim(s) *None* is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-22* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on <u>27 February 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____ .
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>20040901</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

# DETAILED ACTION

## *Claim Rejections - 35 USC § 102*

1.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in
>
> > (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or
> >
> > (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.      Claims 1-12, 14-17 and 19-22 are rejected under 35 U.S.C. 102(e) as being

anticipated by Meyer et al. (US 6,915,271) hereinafter referred to as Meyer.

3.      With respect to **claim 1**:

4.      Meyer discloses a method for processing member information provided within a

file comprised of member and non-member information, without exchanging non-

member personal information, the method comprising:

- receiving transaction information, including member and non-member

  personal information, where the personal information has been converted

into unique transaction fingerprints (Figs. 1 and 2, Col. 2, ll. 50-60, the background of the invention points out transmission of unique transaction information including consumer identification information over the network).

- compiling member information, including member personal information (Fig. 1, col. 3, ll. 55-67, col.5, ll.48-60, col. 8, ll. 11-65, where user's personal profile information is sought and compared).

- converting the member personal information into unique member fingerprints (Fig. 34, col. 2, ll. 30-47, and col. 3, ll. 55-67, where creation of private profiles of users being created and unique user profile being created).

- comparing the unique transaction fingerprints to the unique member fingerprints and producing a list of matching fingerprints (Fig. 3, col. 3, ll. 55-67 and col. 4, ll. 32-48, where usage of a database of user profiles and transaction information is disclosed).

- processing transaction information associated with each of the matching fingerprints (Fig. 3 and col. 2, ll. 47-65, where a code for electronic certificate developed based on transaction data and user identification data).

5.    With respect to **claim 2**:

6.    Meyer discloses member and non-member personal information being converted by using a one-way hash function (Col. 48, ll. 40-67, col. 49, ll. 1-12 and col. 59, ll. 36-44, where encryption of the data being sent to service provider using one-way hash function is performed to assure data integrity).

7.    With respect to **claims 3, 7, 11 and 16**:

8.    Meyer discloses member and non-member personal information is comprised of information selected from the group consisting of a credit card number for the member or non-member, a name for the member or non-member, an address for the member or non-member, a telephone number for the member or non-member, an e-mail address for the member or non-member, or any other personal identifier for the member or non-member (Figs. 1 and 34, col. 4, ll. 20-31, col. 32, ll. 63-67, col. 33, ll. 1-20 and col. 43, ll. 65-67 where the personal information such as name and e-mail address being sought to uniquely identify the consumer).

9.    With respect to **claims 4, 8,12 and 17**:

10.    Meyer discloses member and non-member personal information is identical in format and type (Figs. 1 and 34, col. 4, ll. 20-31, col. 32, ll. 63-67, col. 33, ll. 1-20 and col. 43, ll. 65-67 where same personal information such as name and e-mail address being sought from members and non-members).

11.    With respect to **claim 5**:

12.    Meyer discloses a computer-readable media having instructions for processing member information provided within a file comprised of member and non-member information, without exchanging non-member personal information, the instructions for performing these steps comprising:

- receiving transaction information, including member and non-member personal information, where the personal information has been converted into unique transaction fingerprints (Figs. 1 and 2, Col. 2, ll. 50-60, col. 8, ll. 11-65, col. 9, ll. 55-67 and col. 10, ll. 30-67,where the background of the invention points out transmission of unique transaction information including consumer identification information over the network and different databases registering unique member identification information as well as rewards information).

- compiling member information, including member personal information (Fig. 1, col. 3, ll. 55-67, col.5, ll.48-60, col. 8, ll. 11-65, where user's personal profile information is sought and compared).

- converting the member personal information into unique member fingerprints (Fig. 34, col. 2, ll. 30-47, col. 3, ll. 55-67, where creation of private profiles of users being created and unique user profile being created).

- comparing the unique transaction fingerprints to the unique member
  fingerprints and producing a list of matching fingerprints (Fig. 3, col. 3,
  ll.55-67 and col. 4, ll. 32-48, where usage of a database of user profiles
  and transaction information is disclosed).

- processing transaction information associated with each of the matching
  fingerprints (Fig. 3 and col. 2, ll. 47-65, where a code for electronic
  certificate developed based on transaction data and user identification
  data).

13.    With respect to **claim 6**:

14.    Meyer discloses personal information is converted by using a one-way hash
function (Col. 48, ll. 40-67, col. 49, ll. 1-12 and col. 59, ll. 36-44, where encryption of the
data being sent to service provider using one-way hash function is performed to assure
data integrity).

15.    With respect to **claim 9**:

16.    Meyer discloses a method for determining if a transaction by a member
consumer meets requirements provided by a rewards program, the method comprising:

- receiving transaction information, including information from the group
  consisting of identifying a consumer, information identifying a business
  and information pertaining to the purchase of a good or service by the
  consumer, where the information identifying a consumer has been
  converted into unique transaction fingerprints (Figs. 1 and 2, Col. 2, ll. 50-

60, col. 4, ll. 32-48, col. 32, ll. 25-55, col. 33, ll. 52-67 and col. 41, ll. 45-65,

where a validation process is disclosed which is functional equivalent of

claim limitation).

- providing member consumer information, including information identifying

  a member consumer (Figs. 1 and 2, Col. 2, ll. 50-60, col. 4, ll. 32-48, col.

  32, ll. 25-55, col. 33, ll. 52-67 and col. 41, ll. 45-65, where a system for

  identifying the member is disclosed).

- converting the information identifying a member consumer into unique

  member fingerprints (Fig. 34, col. 2, ll. 30-47, col. 3, ll. 55-67, where

  creation of private profiles of users being created and unique user profile

  being created).

- comparing the unique transaction fingerprints to the unique member

  fingerprints (Fig. 3, col. 3, ll. 55-67 and col. 4, ll. 32-48, where usage of a

  database of user profiles and transaction information is disclosed).

- producing a list of matching fingerprints (Fig. 3, col. 3, ll.55-67 and col. 4,

  ll. 32-48, where usage of a database of user profiles and transaction

  information is disclosed).

- processing transaction information associated with each of the matching

  fingerprints, including information identifying a consumer, information

  identifying a business and information pertaining to the purchase of a

  good or service by the consumer, wherein transaction information for non-

member consumers is not processed (Fig. 3 and col. 2, ll. 47-65, where a

code for electronic certificate developed based on transaction data and

user identification data).

- determining if the business identified in the transaction information is a

  member business (Figs. 1, 2 and 3, col. 6, ll. 44-67, col. 7, ll. 1-15 and col.

  27, ll. 12-27, where a list of merchants is disclosed which is functional

  equivalent of participating member business database).

- if it is determined that the consumer is a member consumer and the

  business is a member business, determining if the information pertaining

  to the purchase of a good or service by the consumer at the business

  meets the requirement of the rewards program (Fig. 1, 2 and 3, col. 43, ll.

  15-57, where a system that checks each item to see if there is an

  incentive applying to that item is disclosed which is functional equivalent of

  the claim limitation of good or service meeting the reward program

  requirements).

17.    With respect to **claim 10**:

18.    Meyer disclose the transaction information including information selected from

the group consisting of information identifying a consumer, information identifying a

business and information pertaining to the purchase of a good or service by the

consumer (Figs. 1 and 2, Col. 2, ll. 50-60, col. 4, ll. 32-48, col. 32, ll. 25-55, col. 33, ll.

52-67 and col. 41, ll. 45-65, where a validation process is disclosed which is functional equivalent of claim limitation).

19.  With respect to **claim 14**:

20.  Meyer discloses the information identifying a consumer and the information identifying a member consumer are converted into unique transaction fingerprints and unique member fingerprints, respectively, by using a one-way hash function (Figs. 1 and 2, Col. 2, ll. 50-60, col. 8, ll. 11-65, col. 9, ll. 55-67 and col. 10, ll. 30-67,where the background of the invention points out transmission of unique transaction information including consumer identification information over the network and different databases registering unique member identification information as well as rewards information, further Col. 48, ll. 40-67, col. 49, ll. 1-12 and col. 59, ll. 36-44, where encryption of the data being sent to service provider using one-way hash function is performed to assure data integrity).

21.  With respect to **claim 15**:

22.  Meyer discloses a method for allowing a consumer to receive benefits associated with an incentive program created by a business, the method comprising:

- accepting a registration of a member consumer entitling the member consumer to benefits of the incentive program, the registration including information identifying a member consumer (Col. 16, ll. 27-46 where a system for a consumer to register with a service provider is disclosed)

- converting the information identifying the member consumer into a unique member fingerprint (Fig. 34, col. 2, ll. 30-47, col. 3, ll. 55-67 and col. 8, ll. 12-37 where creation of private profiles of users being created and unique user profile being created).

- receiving transaction information, including information identifying a consumer, where the information identifying a consumer has been converted into a unique transaction fingerprint (Figs. 1 and 2, Col. 2, ll. 50-60 and col. 9, ll. 33-50, the background of the invention points out transmission of unique transaction information including consumer identification information over the network and discloses a system for member provides identification information along with date and value).

- comparing the unique member fingerprint to the unique transaction fingerprint and producing a list of matching fingerprints (Fig. 3, col. 3, ll. 55-67 and col. 4, ll. 32-48, where usage of a database of user profiles and transaction information is disclosed).

- processing transaction information associated matching fingerprints and determining if the consumer performed a transaction at a member business (Fig. 3 and col. 2, ll. 47-65, where a code for electronic certificate developed based on transaction data and user identification data).

- rewarding the member consumer in accordance with the benefits of the incentive program if it is determined that the consumer did perform a

transaction at the member business (Abstract, col. 42, ll. 37-67 and col.

43, ll. 1-40, where discount/ incentive processing by merchant is

described).

23.    With respect to **claim 19**:

24.    Meyer discloses information identifying a member consumer and the information

identifying a consumer is converted by using a one-way hash function (Col. 48, ll. 40-67,

col. 49, ll. 1-12 and col. 59, ll. 36-44, where encryption of the data being sent to service

provider using one-way hash function is performed to assure data integrity).

25.    With respect to **claim 20**:

26.    Meyer discloses a computer-readable media having instructions for determining if

a transaction by a member consumer meets a requirement of a rewards program of a

member business, the instructions for performing these steps comprising:

- receiving transaction information, including information identifying a

    consumer, where the information identifying a consumer has been converted

    into unique transaction fingerprints (Figs. 1 and 2, Col. 2, ll. 50-60, col. 8, ll.

    11-65, col. 9, ll. 55-67 and col. 10, ll. 30-67,where the background of the

    invention points out transmission of unique transaction information including

    consumer identification information over the network and different databases

    registering unique member identification information as well as rewards

    information).

- providing member consumer information, including information identifying a member consumer (Figs. 1 and 2, Col. 2, ll. 50-60, col. 4, ll. 32-48, col. 32, ll. 25-55, col. 33, ll. 52-67 and col. 41, ll. 45-65, where a system for identifying the member is disclosed).

- converting the information identifying a member consumer in unique member fingerprints (Fig. 34, col. 2, ll. 30-47, col. 3, ll. 55-67, where creation of private profiles of users being created and unique user profile being created).

- comparing the unique transaction fingerprints to the unique member fingerprints (Fig. 3, col. 3, ll. 55-67 and col. 4, ll. 32-48, where usage of a database of user profiles and transaction information is disclosed).

- producing a list of matching fingerprints (Fig. 3, col. 3, ll. 55-67 and col. 4, ll. 32-48, where usage of a database of user profiles and transaction information is disclosed).

- processing transaction information associated with each of the matching fingerprints, wherein transaction information for non-member consumers is not processed (Fig. 3 and col. 2, ll. 47-65, where a code for electronic certificate developed based on transaction data and user identification data).

- determining if the business identified in the transaction information is a member business (Figs. 1, 2 and 3, col. 6, ll. 44-67, col. 7, ll. 1-15 and col. 27, ll. 12-27, where a list of merchants is disclosed which is functional equivalent of participating member business database).

- if it is determined that the consumer is a member consumer and the business is a member business, determining if the information pertaining to the purchase of a good or service by the consumer at the business meets the requirement of the rewards program (Fig. 1, 2 and 3, col. 43, ll. 15-57, where a system that checks each item to see if there is an incentive applying to that item is disclosed which is functional equivalent of the claim limitation of good or service meeting the reward program requirements).

27.    With respect to **claim 21**:

28.    Meyer discloses the transaction information includes information selected from the group consisting of information identifying a consumer, information identifying a business and information pertaining to the purchase of a good or service by the consumer (Figs. 1 and 2, Col. 2, ll. 50-60, col. 4, ll. 32-48, col. 32, ll. 25-55, col. 33, ll. 52-67 and col. 41, ll. 45-65, where a validation process is disclosed which is functional equivalent of claim limitation).

29.    With respect to **claim 22**:

30.    Meyer discloses the transaction information and consumer information is converted into unique transaction fingerprints and unique member fingerprints by using a one-way hash function (Col. 48, ll. 40-67, col. 49, ll. 1-12 and col. 59, ll. 36-44, where encryption of the data being sent to service provider using one-way hash function is performed to assure data integrity).

## *Claim Rejections - 35 USC § 103*

31.     The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

32.     The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.      Determining the scope and contents of the prior art.
2.      Ascertaining the differences between the prior art and the claims at issue.
3.      Resolving the level of ordinary skill in the pertinent art.
4.      Considering objective evidence present in the application indicating obviousness or nonobviousness.

33.     Claims 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Meyer, in view of Walker et al (US 6,327,573).

34.     With respect to **claims 13 and 18**:

35.     Meyer discloses a method for processing member information provided within a

file comprised of member and non-member information, without exchanging non-

member personal information, as applied above in the rejection of claims 1-12, 14-17

and 19-22 under 35 U.S.C. 102(e), and Meyer discloses storing occurrence information

that includes member identification, date and time (Col. 8, ll. 12-37), but Meyer does not

explicitly disclose information pertaining to the purchase of good or service by the

consumer at the business comprising information selected from the group consisting of a sale amount, a day of sale and a time of sale.

However, Walker et al. teaches (Col. 7, ll. 40-45 and col. 9, ll. 32-41) a system for capturing information such as item sold, transaction date, quantity and other required transaction details.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of invention to combine the system of Meyer and Walker to formulate a consumer reward system to provide incentives to consumers to buy goods or services or to reward consumer for a particular consumer behavior, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

## *Conclusion*

36.    The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Feidelson et al (US 6,345,261) – A system and method of customer loyalty program where purchase rebates are used.

37.    Any inquiry concerning this communication or earlier communications from the examiner should be directed to MURALI K. DEGA whose telephone number is (571) 270-5394.  The examiner can normally be reached Monday to Thursday, 7.30 to 5.00.

38.    If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

39.    Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. K. D./
Examiner, Art Unit 4176

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 4176